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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,380	07/12/2001	Jane H. Morse	62430-A/JPW/SHS	1634

7590                    09/10/2002

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[REDACTED] EXAMINER

HORLICK, KENNETH R

[REDACTED] ART UNIT      [REDACTED] PAPER NUMBER

1637

DATE MAILED: 09/10/2002

*[Signature]*

Please find below and/or attached an Office communication concerning this application or proceeding.

**Offic Action Summary**

Application No.

09/904,380

Applicant(s)

MORSE ET AL.

Examiner

KENNETH HORLICK

Art Unit

1637

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on Amendment filed 10/15/01.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-60 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 1-60 are subject to restriction and/or election requirement.

  
SHARON N. THORNTON  
PATENT ANALYST**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other:

**1. *Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-52 and 56, drawn to methods of detecting bone morphogenic protein receptor-II gene mutations, classified in class 435, subclass 6.
- II. Claim 53, drawn to a method of preventing/treating FPPH using a nucleic acid, classified in class 514, subclass 44.
- III. Claim 55, drawn to a method of preventing/treating FPPH using a protein, classified in class 514, subclass 2.
- IV. Claims 57 and 59, drawn to methods of screening for a compound and obtaining a composition, classified in class 435, subclass 4.
- V. Claim 60, drawn to a transgenic non-human animal, classified in class 800, subclass 13.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and different functions. The first invention involves diagnostic methods for detecting gene mutations; the second invention involves therapeutic treatment using a nucleic acid; the third

invention involves therapeutic treatment using a protein; the fourth invention involves screening for a compound; the fifth invention involves a transgenic animal that is not used in any of the methods. Thus, the search for each of the different inventions covers non-overlapping subject matter, and undue search burden on the Office would clearly occur in searching more than one group at the same time.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and the search required for each of Groups I-V is not required for any of the other Groups, restriction for examination purposes as indicated is proper.

2. A telephone call was made to Deepro Mukerjee on 08/27/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth R Horlick whose telephone number is 703-308-3905. The examiner can normally be reached on Monday-Thursday 6:30AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703-308-1119. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

*Kenneth R. Horlick, Ph.D.*  
Kenneth R Horlick  
Primary Examiner  
Art Unit 1637

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August 29, 2002